

FITZPATRICK, CELLA, HARPER & SCINTO

650 Town Center Drive
Suite 1600
Costa Mesa, California 92626-7130
(714)540-8700

Facsimile: (714)540-9823

RECEIVED
GENERAL FAX CENTER

FEB 18 2005

FACSIMILE COVER SHEET

TO: Examiner C. Stulberger
Group Art Unit 2132

FROM: Michael K. O'Neill

RE: U.S. Application No. 09/411,070
Atty. Docket No.: 03630.000229

FAX NO.: (703) 872-9306

DATE: February 18, 2005

NO. OF PAGES: 5
(including cover page)

TIME: 3:40

SENT BY: *Harmon*

MESSAGE

Attached is a Response to Final Rejection and Statement of Substance of Interview, responsive to the final Office Action dated December 6, 2004.

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

BEST AVAILABLE COPY

February 18, 2005
(Date of Deposit)

Michael K. O'Neill, Reg. No. 32,622
(Name of Attorney for Applicant)

Michael K. O'Neill
Signature

February 18, 2005
Date of Signature

**IF YOU DO NOT RECEIVE ALL THE PAGES,
PLEASE CALL 714-540-8700 AS SOON AS POSSIBLE.**

Note: We are transmitting from a Canon Model FAX-L770
(compatible with any Group I, Group II or Group III machine).

THIS FACSIMILE MESSAGE AND ACCOMPANYING DOCUMENTS ARE INTENDED ONLY FOR THE USE OF THE ADDRESSEE INDICATED ABOVE. INFORMATION THAT IS PRIVILEGED OR OTHERWISE CONFIDENTIAL MAY BE CONTAINED THEREIN. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, REVIEW OR USE OF THIS MESSAGE, DOCUMENTS OR INFORMATION CONTAINED THEREIN IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS MESSAGE IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE OR FACSIMILE AND MAIL THE ORIGINAL TO US AT THE ABOVE ADDRESS. THANK YOU.

Response Under 37 C.F.R. § 1.116
Group Art Unit 2132, Expedited Procedure

03630.000229

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: C. Stulberger
ROYCE E. SLICK, et al.)
: Group Art Unit: 2132
Application No.: 09/411,070)
:
Filed: October 4, 1999)
:
For: TARGETED SECURE)
PRINTING)
: February 18, 2005

RECEIVED
CENTRAL FAX CENTER

FEB 18 2005

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO FINAL REJECTION
AND
STATEMENT OF SUBSTANCE OF INTERVIEW

Sir:

This is a Response to the Office Action dated December 6, 2004, which entered a final rejection of all claims under 35 U.S.C. § 103(a) primarily over U.S. Patent 5,633,932 (Davis) in view of U.S. Patent 5,956,407 (Slavin), or over U.S. Patent 6,378,070 (Chan) in view of Slavin. Claims 1 to 104 and 122 to 140 are pending in the application. Reconsideration and further examination are respectfully requested.

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

February 18, 2005
(Date of Deposit)

Michael K. O'Neill, Reg. No. 32,622
(Name of Attorney for Applicant)

Signature

February 18, 2005
Date of Signature

The undersigned thanks Examiner Stulberger and Supervisory Examiner Barron for the courtesies and thoughtful treatment afforded during a personal interview conducted on February 16, 2005. A statement of the substance of the interview follows.

It was explained at the interview that the invention involves a double-encryption using first and second pairs of private-keys/public keys. According to one feature of the invention, the private key of the first private-key/public key pair is primarily in the sole possession of an intended image output device, whereas the private key of the second private-key/public key pair is primarily in the sole possession of the intended recipient of the image. It was further explained that one advantageous effect of this feature was an added degree of assurance in a secure printing environment: since the first private key is primarily in the sole possession of the intended image output device there is assurance that a print job could not successfully be intercepted by an unintended image output device; and since the second private key is primarily in the sole possession of the intended recipient of the image, there is assurance that an unauthorized person could not obtain the printed image even from the intended image output device.

The rejection relies on the secondary reference to Slavin (at column 13) which shows a double-encryption process based on first and second private-key/public key pairs. It was agreed at the interview, however, that Slavin was deficient in that it did not show that the private keys of the private-key/public key pairs are primarily in the sole possession of different entities. As a consequence, Slavin did not obtain the advantageous effect of the invention since even an unintended or unauthorized recipient could obtain a printed copy of a secure document.

A question arose during the interview of the meaning of the qualifier "primarily" in the phrase "primarily in the sole possession...". The word "primarily" was chosen deliberately to allow for the possibility that others with authorization or permission might also have possession the private key, but the full phrase of "primarily in the sole possession ..." clearly is not the same as the arrangement of Slavin in which both private keys are held exclusively by the exact same entity. This meaning is consistent with that explained in the specification, such as at lines 2 through 11 on page 6:

"In the preferred embodiment, the second key is contained in a smart-card which is in the possession of the intended recipient. Thus, the second key is primarily accessible only with permission by the intended recipient. Likewise, the third key is preferably maintained in a smart-chip which is maintained internally in the intended image output device, thereby being shielded from access by devices other than the intended image output device."

Finally, it was agreed at the interview that upon filing of these remarks, the final rejection would be withdrawn and an updated search would be conducted. These actions are respectfully requested.

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed to
our below-listed address.

Respectfully submitted,



Michael K. O'Neill
Attorney for Applicants
Registration No. 32,622

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-2200
Facsimile: (212) 218-2200

CA_MAIN 92334V1

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☒ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.